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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/673,260

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Koichiro Mitsui

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LOWE HAUPTMAN HAM & BERNER, LLP
1700 DIAGONAL ROAD
SUITE 300
ALEXANDRIA, VA 22314

EXAMINER

HAND, MELANIE JO

ART UNIT

PAPER NUMBER

3761

MAIL DATE

DELIVERY MODE

03/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/673,260	Applicant(s) MITSUI ET AL.	
	Examiner MELANIE J. HAND	Art Unit 3761	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 February 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1,3-5,8-11,15,21-31.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
Please see attached communication.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Tatyana Zalukaeva/
Supervisory Patent Examiner, Art Unit 3761

/Melanie J Hand/
Examiner, Art Unit 3761

1. With respect to applicant's arguments regarding whether Suekane is an enabling disclosure because applicant found Suekane confusing and hard to understand, applicant is directed to applicant's own PTO-1449 form filed October 11, 2007 and the accompanying foreign reference document submitted and of record in the prosecution history. If this reference is unclear, confusing or non-enabling, it is because applicant submitted an unclear, confusing and non-enabling reference. Thus, applicant's request for an accurate and complete translation is refused.

2. As to applicant's arguments regarding claim 1, applicant argues that the secondary references cited to support the taking of official notice regarding elastic sheets sandwiched between upper and lower nonwoven fabric layers as well-known in the art do not provide such support and requests specific citations. At applicant's request, the following citations from the Gesp, Borgers and Pape references are given herein: Gesp, Fig. 1, Col. 1, lines 32-37, Col. 3, lines 4-7; Borgers, Fig. 1, Col. 4, lines 20-25, Col. 5, lines 19-22; Pape, Figs. 3-5, Abstract, Col. 2, lines 62-65. With further regard to Pape, selectively choosing one embodiment as a basis for argument is insufficient to overcome the rejection. As to applicant's argument that the engaging portion of Suekane in the form of adhesive 20 engageable with hooks 15 teaches away from applicant's disclosure criticizing adhesive, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the engaging portion must not contain adhesive) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to applicant's argument that the outer surface of front sheet 2 of Suekane does not meet the limitations regarding a non-engaging portion that is part of an engaging portion that is in turn part of the side flap, this argument is not persuasive for two reasons. First, the engaging region comprising the non-engaging portion is not part of the side flap, rather it is disposed on the side flap and thus physically separate. Second, the rejection of claim 1 clearly recites "a non-engaging portion shown in Fig. 2 and defined by the surface of front sheet 2 with which said hook member can barely be engaged or not at all". (Office action mailed 12/20/07, Page 3, lines 6-9) Examiner clarifies herein that the non-engaging portion of flap 10 is the portion of flap 10 (not sheet 2) that is under a portion of sheet 2 with which the hook member can barely be engaged or not at all and whose extent sets and defines the boundaries of the non-engageable portion of flap 10 that lies thereunder. That portion lying under sheet 2 is also non-engaging with respect to the hook member because the sheet 2 physically obstructs access by the hook member 15 to that portion of the flap 10.

As to applicant's argument that examiner did not address the "plurality of factors" that must be properly analyzed to apply the "obvious to try" motivation and the "KSR" case law, there are four factors in MPEP 2143, subsection E listed explicitly that must be addressed. Each is addressed in detail in full in the Office action (Office action mailed 12/20/07, Page 3, line 13 - Page 4, line 3) and in nearly identical language to that of the factors in MPEP 2143 so as to make it clear that these issues were considered and addressed when applying the "obvious to try" motivation.

Applicant has requested evidence supporting examiner's allegation in the rejection of claim 1 that it would be obvious to one of ordinary skill in the art to modify the article of Suekane so as to comprise a fixing tape substrate comprised nonwoven thermoplastic film. However, applicant is unclear regarding what exactly demands further evidence from the Office, the very statement of the rationale or the clear and widely documented and understood technical reasoning regarding the desirability of using hot melt adhesives with hot melt sheet materials that is cited in support of the rationale. As such, a mere request for further evidence is not sufficient to overcome the rejection of claim 1.

As to applicant's argument that examiner's statement on Page 4, lines 15,16 is not understood, examiner in turn does not understand precisely what is unclear. Examiner is aware that plastic film and nonwoven fabric are two different entities. However, plastic films are examples of nonwovens. Applicant is required that claim 1 only requires a fixing tape substrate. A thermoplastic film substrate would yield the low-engaging force with hook member 15 required in claim 1. A thermoplastic film is a species of the genus that is nonwoven fabrics. Thus the prior art of Suekane fairly suggests a fixing substrate comprised of a nonwoven fabric having a low engaging force with the instant hook member and thus meets that limitation of claim 1.

3. Applicants' arguments with regard to dependent claims 2-5, 8-11 and 15 have been fully considered but are not persuasive as Applicants' arguments depend entirely on Applicants' arguments regarding the rejection of claim 1, which have been addressed supra.

4. As to applicant's additional argument regarding claim 9 that Suekane does not teach or suggest that base member 21 is folded in the manner required in claim 9, applicant is referred to Fig. 2 where Suekane clearly teaches that the base member 21 is both folded and capable of being folded in the manner required in claim 9. Since Suekane is capable of being folded in this manner, and the rejection of claim 9 is under 35 U.S.C. 103, the statement that the base member 21 of Suekane is foldable is sufficient to address the limitation.

5. As to applicant's additional argument regarding claims 15 and 31, specifically that Tanzer fails to teach or suggest the quoted limitation of claims 15 and 31, this argument is not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

6. Suekane teaches a side flap in the form of a fastening tape. Tanzer teaches a fastening tape. Tanzer teaches a fastening tape with "an opening (80) in the attaching portion (defined by area of layer 78 having islands 64 of attachment material disposed thereon), a portion of the surface of the side flap (defined by the inner surface of layer 78) being exposed through the opening (see Fig. 6) and mechanically engageable with the hook members (66 and other hook islands 64) when the fixing tape (60) is folded back because there are also hook members in the openings 80. The numerals in parentheses are the reference characters for the relevant elements of the tape 60 of Tanzer.

7. Applicant's arguments regarding claim 21 on page 5 of the Remarks have been fully considered but are not persuasive as they are based upon arguments presented with respect to claim 1.